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09/954,612	09/12/2001	Ping Liu	034300-172	8236

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EXAMINER

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ART UNIT	PAPER NUMBER
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2115

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/954,612
Filing Date: September 12, 2001
Appellant(s): LIU, PING

MAILED

FEB 7 0 2007

Technology Center 2100

Suvashis Bhattacharya
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/21/06 appealing from the Office action mailed 4/25/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,768,605	FULLER	6-1998
6,573,868	JOHNSON	6-2003

(9) Grounds of Rejection

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The following ground(s) of rejection are applicable to the appealed claims:

Claims 9, 10, 12, 13, 16-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller et al. (Fuller), U.S. patent no. 5,768,605 in view of Johnson et al. (Johnson), U.S. patent no. 6,573,868. The rejection is set forth in prior Office Action, Paper No. 20060421, and is reproduced below:

Appellant did not separately argue the dependent claims. There are three independent claims, namely claims 9, 16 and 25. Independent claim 9 is a method claim. Claim 16 is written in means plus function and contained the same limitations as claim 9. Independent claim 25 is an apparatus claim corresponding the method claim 9. Claim 25 therefore is selected as an exemplary in the rejection below.

Attention of the Board is respectfully directed to Figures 5-7 and the corresponding description in Fuller; and Figures 6A and 6B and the corresponding description in Johnson. With respect to claim 25, Fuller and Johnson together disclose:

As per claim 25, Fuller discloses that a peripheral device adapted to be insertable into a host device [figures 5-7] comprising:

a body [PCMCIA card] adapted to be selectively removable from the host device [figures 5-7; col. 4, lines 1-2];

an antenna [col. 5, lines 13-17; col. 6, lines 2] coupled to the body and moveable between a first position and a second position [fig. 7; col. 5, lines 10-38];

a circuit within the body and configured to sense positioning of the antenna in the first or second position [col. 5, lines 10-38], the circuit configured to provide an inserted signal to the host device when the antenna is in the first position such that the host

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device provides power to the peripheral device in response to the inserted signal [col. 4, lines 38-44; col. 5, lines 36-38], the circuit configured to generate a removed signal to the host device when the antenna is in the second position such that the host device does not provide power to the peripheral device in response to the removed signal [figs. 5-7; col. 5, lines 10-38; col. 6, lines 1-19].

Fuller does not explicitly disclose that the host device does not provide power to the antenna in response to the remove signal. In other word, a switch is configured to generate a signal (remove signal) base on the position of an antenna whether or not to supply power to the antenna.

However, Johnson discloses that a switch [figures 6a, 6b] is configured to generate a signal base on the position of an antenna whether or not to supply power to the antenna [figures 12a, 12b; col. 13, lines 1-14; col. 15, line 66-col. 16, line 12; col. 16, lines 42-47].

It would have been obvious to one of ordinary skill in the art at time the invention to combine the teachings of Fuller and Johnson, because they teach a communication PC card and the specific teaching of Johnson that would improve the performance of Fuller's system by further reducing power consumption of Fuller's system.

(10) Response to Argument

In the Appeal Brief, Appellant argued in substance that 1) Fuller and Johnson teach away from one another. Such that Johnson teaches away from powering off the PCMCIA card when the antenna is retracted. 2) There is no suggestion and motivation in combining Fuller and Johnson.

The examiner respectfully traverses the argument. As to point 1) Fuller teaches of powering off the PCMCIA card based on a remove signal (a signal is generated based on the position of an antenna), and that Johnson is only being relied upon to teach a switch that is activated/deactivate the power supplying to the antenna according to the position of the antenna. Therefore, Johnson does not expressly teach away from powering off the antenna, particularly in the embodiment of Fuller relying on for the teaching.

As to point 2) The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Fuller does not explicitly disclose that the host device does not provide power to the antenna in response to the remove signal. In other word, a switch is configured to generate a signal (remove signal) base on the position of an antenna whether or not to supply power to the antenna. However, Johnson discloses that a switch [figures 6a, 6b] is configured to generate a signal base on the position of an antenna whether or not to supply power to the antenna [figures 12a, 12b; col. 13, lines 1-14; col. 15, line 66-col. 16, line 12; col. 16, lines 42-47]. It would have been obvious to one of ordinary skill in the art at time the invention to combine the teachings of Fuller and Johnson, because by adding a switch

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as taught by Johnson would in fact help Fuller fulfill its intended purpose and further reducing the power consumption of Fuller's system.

In summary, Fuller and Johnson both teach a PCMCIA card for using with a computer system that provides a system for reducing unnecessary power consumption. Fuller and Johnson meet all the claim limitations as shown in the rejection above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Chun Cao



CHUN CAO
PRIMARY EXAMINER

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